

## **35 USC § 112 responses:**

### ***Item 7:***

Page 10, paragraph 3: Change "... for the date range." to "... for the date range aggregating all periodic donations made during for each donor and all donors. This aggregation eliminates reporting multiple and redundant donations by the same donor when reporting to the organization."

Page 10, paragraph 3: Change "... subscriber information to that file." to "... aggregated donor information to that file for reports to each organization."

Page 8, paragraph 1: Append with "A donor can select a donation value of zero, which will effectively terminate their future donations, or they may select a specific screen option to terminate donations."

### ***Item 9:***

Corrected in revised claim (parenthetical example removed, and specific claim elements enumerated).

### ***Item 10:***

Corrected in revised claim. It should be noted that the invention is intended to provide donors with an automatically recurring payment system, which is a form of subscription. I have attempted to consolidate the language in the enclosed revisions, but within the invention "subscriber" and "donor" are for practical purposes interchangeable terms.

## **35 USC § 101 responses:**

### ***Item 12:***

Corrected in revised claims for Examiner suggestion.

## **Overview of 35 USC § 102 responses:**

Re: Burke: It should be noted that Burke and Applicant (Smith) envision very different methods and means for accomplishing two very different objectives. It is difficult to compare the whole or the part of Burke to Smith's invention given this. Specifically:

**Periodical nature:** Smith's invention enables regularly scheduled donations. Burke envisions ad hoc donations based on opportunity and spontaneity. The unique results by Smith include, as stated in the original application, include the predictability of payments by donors, and income by donees – benefits Burke does not claim or deliver.

**Donation amounts:** Smith's invention delivers specific, fixed amounts for donations on a periodic basis, which establishes the unique benefit to both donor and donee. Amounts delivered via Burke are dictated primarily by the amount of

purchases, and thus are completely discretionary and avoid addressing benefits established by Smith.

These key elements in Smith address long-felt and unsolved needs of both donors and donees. In this context, the specific steps in Burke and Smith are dissimilar.

***Item 14 - claims 1,2 & 4:***

**Registering donors:** Burke is non-specific about how donors are registered, though Burke anticipates using keypads attached to cash registers as a dominant means. Smith envisions common Internet and other client/server technologies. The key point is that the process of collecting personal information from donors, and recording that information in a database has been exhibited in various prior art for many decades. Burke and Smith have detailed two mechanically different means of capturing donor information as part of a broader, and significantly different process.

**Allowing donors to select organizations to donate to:** An essential step for donors who want to receive receipts for tax purposes is a form of registration. This requirement pre-existed either Burk or Smith, and is a foundation of most recurring charitable activities. Neither Burke or Smith claim this step to be unobvious, but as housekeeping function that supports automating their respective and otherwise dissimilar inventions.

**... and amount to donate to each:** Burke specifically envisions allocation of spontaneous donations by percentages. Smith specifies fixed currency amounts to donate at regular periods.

**... on a periodic basis:** Burke does not envision periodic donations at all. Burke's invention depends entirely on the purchasing habits of potential donors, and their spontaneous inclination to donate. Smith specifies regularly scheduled donations.

**Collecting money from donors on a periodic basis on their said specific donations:** Burke envisions a system of collecting excess payments for a purchase (change), which is inherently non-predictable as the amount of a purchase, the amount of change, and the frequency of donation are all random. Smith specifies predictable, periodic intervals for donating and fixed donation amounts.

**Calculating the sum of all donations for each organization:** Burke envisions a system of reporting to the donor their cumulative donations over a variable amount of time. Smith specifies the reporting (a) to organizations of (b) donations made by (c) individuals over (d) a specific period of time. Additionally, Burke (column 3 lines 22-27) does not specify that reporting to the organizations is ever performed -- only that money is transferred.

***Item 14 - claim 3:***

**Counting the number of rejected billings:** Burke (column 5 lines 40-43) envisions rejecting unauthorized donations through a Personal Identification Number (PIN), with the goal of ensuring that donations are not inappropriately made or that non-authorized

individuals cannot change donation information. Smith specifies responding to rejected charges against a donor's payment mechanism (such as a credit or debit card) given common expiry of such, and notification to the donor for the purpose of assuring they update their personal information and continue donating. The revised claim herein amplifies the distinction and established positive limitation.

**Claim 4, Burke teaches a donor terminating donations (figure 4, #124, #127, #130):** The cited figures shows how a donor may decide to proceed to make a spontaneous donation to all registered organizations, and encompasses interaction with Burke's "device". Smith specifies how a donor prevents future periodic donations to specific individual organizations.

### **Overview of 35 USC § 103 responses:**

**Discussion concerning Mull:** Examiner cites Mull (6,898,575) as prior art. Though details of the difference and unique essence of Smith's invention follows, it is noted:

- Smith's patent was filed on 04/09/2001 and Mull's application was on 05/10/2001. Smith filed more than a month before Mull.
- Smith demonstrates that his invention was conceived 01/21/2000 as evidenced by the enclosed copy of Smith's "lab book", which was witnessed by two non-related individuals on 03/24/2001 (enclosure #3)
- Smith's invention was reduced to practice and made public by 02/11/2001, which was before either filing.

As such, any conflict with Mull is overcome by demonstrated prior filing and prior art by Smith. So established, Mull is invalidated against Smith claims.

#### ***Item 17:***

**Mull:** See " Discussion concerning Mull" above.

**Burke and Mull on claim #2:** There are several points within the rejection that should be reconsidered.

- a) Mull does not teach a communication of requests from donor to donee (Mull teaches how to donate for pre-defined and advertised needs of the donee ). Thus, Mull offers nothing related to Smith's claim.
- b) Mull teaching nothing about reducing redundant reporting. If a donor makes multiple donations, Mull's system creates multiple reports to the donee – one for each transaction. Smith teaches the aggregation of donation records, as well as the aggregation of action requests, and reduces redundant reporting in two areas of concern.
- c) The references take mutually exclusive paths and reach different solutions to entirely different problems. Since they teach away from each other, it would not be logical or obvious to combine them.

- d) Even if combined, the references would not meet the claims in Smith which establish recurrence of donations as a unique feature and benefit.
- e) Again, Smith's earlier filing and reduction to practice of the invention invalidates any prior art claims by Mull and renders objections moot.

### **Conclusion**

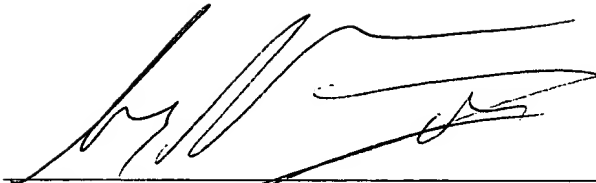
For all of the above reasons, applicant submits that the specification and claims are now in the proper form. Applicant also submits that examiner cited patents are either non-applicable as prior art, and that one patent follows applicant's claim in filing and in being reduced to practice. Therefore the applicant submits that this application now in condition for allowance, which action he respectfully solicits.

### **Conditional Request For Constructive Assistance**

Applicant has amended the specification and claims of this application so that they are proper, definite, and define novel structure which was also unobvious at the time of original application. If, for any reason this application is not believed to be in full condition for allowance, applicants respectfully request the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P § 2173.02 and § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

### **Conditional Request For Expediting**

The applicant originally filed more than five years before the date of this response. Applicant respectfully requests that review of this response, any constructive assistance, and award of patent be expedited so that the applicant can have the fullest benefit of the patent when awarded.



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***Certificate of mailing***

I certify on the date below and referenced attachments/enclosures, if any, will be deposited with the U.S. Postal Service as first class mail in an envelope addressed to "BOX Non-Fee Amendments, Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450."

05/22/2006



Guy Smith, Applicant

**Enclosure - #1 - revised drawings**